



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

TB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,228	03/14/2001	Brian W. McKinnon	10557/199332	5554

30559 7590 07/01/2003

CHIEF PATENT COUNSEL
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
----------	--------------

3738

10

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,228

Applicant(s)

MCKINNON, BRIAN W.

Examiner

Thomas C. Barrett

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-181 is/are pending in the application.
- 4a) Of the above claim(s) 1-101, 111-115, 131-134, 136, 137, 140-142 and 144-181 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 102-110, 116-130, 135, 138, 139 and 143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6 .

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

U.S. Patent and Trademark Office
PTO-326 (Rev. 04-01)

Office Action Summary

Part of Paper No. 10

DETAILED ACTION

Election/Restrictions

Claims 1-101, 111-115, 131-134, 136-137, 140-142, and 144-181 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Applicant's election with traverse of Species I, sub-species (i), and sub-sub-species (A) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that a different field of search is not required for examination. This is not found persuasive because in a restriction of species that are independent inventions, it is not necessary to show a separate status in the art or separate classification. Therefore a species restriction does not require further search or significant burden.

Furthermore, as noted in the prior action: "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case."

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The information disclosure statement filed August 27, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Harkness, et al. reference does not have a date and place of publication. The Harkness et al. reference

Art Unit: 3738

has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The use of the trademarks "UNIGRAPHICS", "WINDOWS NT", "PENTIUM II" and "SYNERGY" has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

The specification is also objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the liner internal concave surface is only disclosed as shifted laterally up to 8 mm or medially up to 4 mm. Additionally, the center axis of the liner internal concave surface is only disclosed as anteverted 20 degrees.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 107-110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 107-108 are ambiguous and therefore indefinite as to whether the Applicant is claiming a product ("femoral component" or a process ("**employing** femoral components to define said sculpted surface").

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 107-110 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 107-110 are directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Please Note: The products of the prior art cited below have the same ***structural*** limitations as those claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 102-106, 135, 138-139 and 143 are rejected under 35 U.S.C. 102(b) as anticipated by Thornberry et al. as disclosed in applicant's IDS. Thornberry et al. disclose a prosthetic device comprising: an acetabular shell, an acetabular liner and a femoral component. (See "Results and Discussion"). The shape of the sculpted surface varies around the rim of the liner ("wide chamfer") and is symmetric about a plane ("small chamfer").

Art Unit: 3738

Claims 102 and 117-124 are rejected under 35 U.S.C. 102(b) as anticipated by Smith & Nephew (Reflection Lateralized Liners...) as disclosed in applicants IDS. Smith & Nephew discloses a prosthetic device comprising: an acetabular shell and an acetabular liner. The liner has a distance across the opening of the internal concave surface of 28mm, a shoulder, a serrated locking surface and a lateral offset of 4mm. The external surface of the "Lateralized Liners" is adapted to be received in a "Reflection InterFit" acetabular shell, which, as disclosed in the "Catalog Information" of "Smith & Nephew Surgical Technique" as cited in applicant's IDS, has an external diameter of 42-76 mm.

Claims 102 and 126-130 are rejected under 35 U.S.C. 102(b) as anticipated by Lennox. Lennox discloses a prosthetic device comprising: an acetabular shell and an acetabular liner (Fig. 1). The liner has a center axis oriented 20 degrees to the axis of the shell (col. 8, lines 51-64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 102, 122 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateman et al. Bateman et al. discloses a prosthetic device comprising: an acetabular shell, an acetabular liner and medially shifted liner (Fig. 4)

Art Unit: 3738

however Bateman et al. fails to disclose the liner shifted medially specifically up to 8 mm.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to shift the liner medially specifically up to 8 mm. Applicant has not disclosed that shifting the liner medially specifically up to 8 mm provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the liner medially shifted specifically up to 8 mm because there is no disclosed advantage over a specific length of medial shift.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Bateman et al. to obtain the invention as specified in claim 125.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3580 for regular communications.

Art Unit: 3738

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0850.



Thomas Barrett
June 20, 2003



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700